

SUMMARY OF SPECIES ELECTION

The Election Requirement states as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention: A number of metal oxide-organopolysiloxane is claimed.

Applicant is required under 35 U.S.C. §121 to elect a single metal oxide-organopolysiloxane disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 6 are generic.

PROVISIONAL ELECTION

Applicants provisionally elect titanium as the metal oxide component and a compound as shown in formula (4) at page 5 of the specification as the organopolysiloxane. Presently pending claims 1-11 and 14-17 are all readable upon thereon.

In the event the Restriction is not overcome, Applicants specifically preserve the right to pursue the subject matter of the un-elected subject matter in later applications and for purposes of preserving the record for appeal.

TRAVERSAL

Applicants respectfully traverse the Examiner's Restriction Requirement because presently pending claims 1-11 and 14-17 do not recite mutually exclusive limitations that separate the alleged metal oxide-organopolysiloxane species from each other.

Binding precedent states that the touchstone for requiring restriction is determining whether two or more independent and distinct inventions are claimed within the same application. MPEP §806. Restriction should never be required where the claims of an application define the same essential characteristics of a single disclosed embodiment of the invention. MPEP §806.03.

Furthermore, claims alleged to be drawn to different species must contain mutually exclusive limitations defining those allegedly different species. MPEP §806.04(f). For example, a proper restriction can be made between a first claim reciting limitations which under the disclosure are found in a first species but not in a second, and a second claim reciting limitations disclosed only for the second species and not the first. Id. In other words, claims to be restricted to different species must contain within the language of the claim the mutually exclusive limitations for those species.

In the present application, claims 1-11 and 14-17 do not recite mutually exclusive limitations that separate the alleged species of metal oxide-organopolysiloxane from each other. In particular, the single independent claim 1 recites a metal oxide-organopolysiloxane, wherein a silicon atom of organopolysiloxane is bonded by covalent bond with a metal atom through an oxygen atom. Nowhere within claim 1 are there any limitations directed to mutually specific limitations between metal oxide-organopolysiloxane species in general.

Turning to the Office Action's assertion that Applicants are required to state that the species are unpatentable (obvious) over the other, Applicants note that no need exists for such a statement because the disclosure shows a relationship between all the presently claimed metal oxide-organopolysiloxanes. Applicants note that this statement, however, is not in any way asserting or making a characterization regarding the patentability or the nature of the invention by these statements.

For all these reasons, Applicants respectfully request that the Restriction be withdrawn.

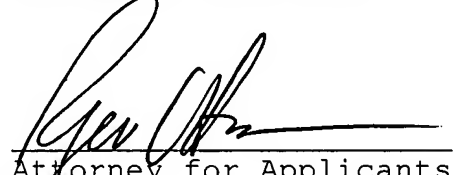
CONCLUSION

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement and to examine all of the claims pending in this application.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

SHERMAN & SHALLOWAY



Attorney for Applicants
Roger C. Hahn
Reg. No. 46,376

SHERMAN AND SHALLOWAY
P.O. Box 788
Alexandria, Virginia 22313
(703) 549-2282